79.   (New) The original watch design creating method of claim 68, further comprising a step of,

inputting in the consumer terminal, watch design information independently created by the consumer,

and wherein the original watch design information includes the watch design information.

80.   (New) The original watch design creating method of claim 68, wherein the original watch design information includes material information of the watch constituent parts.

81.   (New) The original watch design creating method of claim 68, wherein the original watch design information includes mechanical function information of the watch constituent parts.

REMARKS

The cancellation of claims 1, 3, 10, 11, 14, 16, 18, 22, 24, 30-38, 42, 43, and 45-67 leaves only new claims 68-81 remaining in the application.

In paragraphs numbered 3 through 3-5, bridging pages 2 and 3 of the Office Action, the Examiner objected to the drawings on grounds based principally on inconsistencies between several of the drawing figures and the specification. In response, Applicants have obviated the grounds for objections to the drawings in paragraphs 3-1 to 3-4 by amendments to the specification. A Request for Approval of Drawing Change is submitted to address the issues raised in paragraph 3-5 regarding the message displays in Fig. 34.

In paragraphs numbered 4 through 4-7 bridging pages 3 and 4 of the Office Action, the Examiner sets forth various objections to the specification. Grounds for

each of these objections is believed obviated by the amendments made herein to the specification.

In paragraphs numbered 5 through 5-6 on pages 4-6 of the Office Action, the Examiner objected to several claims on formal grounds. Replacement of all prior claims with new claims 68-81 renders these objections moot in that the new claims are deemed to be in proper form. Similarly, the claim rejections based on 35 U.S.C. § 112, second paragraph (pages 6-8 of the Office Action) are no longer applicable in light of the substitution of the new claims.

Substantively and beginning on page 8 of the Office Action, the Examiner rejected claims 1, 3, 10, 11, 14, 45-58, and 64-67 under 35 U.S.C. § 102(b) as being anticipated by Matsuzaki et al. (U.S. Patent No. 5,357,439); rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Abraham et al. (U.S. Patent No. 5,570,292); rejected claims 3, 10, and 11 under 35 U.S.C. § 102(e) as being anticipated by Camaisa et al. (U.S. Patent No. 5,845,263); rejected claims 14, 45-58, and 64-67 under 35 U.S.C. § 102(b) as being anticipated by Hutton (U.S. Patent No. 5,440,479); rejected claims 16, 22, 36, and 59-63 under 35 U.S.C. § 103(a) as being unpatentable over Matsuzaki et al. in view of Greene et al. (U.S. Patent Des. No. 379,067); rejected claims 16, 22, 36, and 59-63 under 35 U.S.C. § 103(a) as being unpatentable over Abraham et al. in view of Greene et al.; rejected claims 18, 24, 30, 34, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Matsuzaki et al. in view of d'Huart (U.S. Patent Des. No. 345,509); rejected claims 18, 24, 30, 34, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Abraham et al. in view of d'Huart ; rejected claims 31-33, 35 and 38 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of

Matsuzaki et al., d'Huart, and further in view of Maxey et al. "New Rider's Reference Guide to Auto Cad Release 13", New Rider's Publishing, Indianapolis, Indiana, 1995; rejected claims 31-33, 35 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Abraham et al. and d'Huart, and further in view of Maxey et al.; rejected claim 37 under 35 U.S.C. § 103(a) as being unpatentable over Matsuzaki et al., Greene et al. and further in view of Maxey et al.; and rejected claim 37 under 35 U.S.C. § 103(a) as being unpatentable over Abraham et al., Greene et al. and further in view of Maxey et al.

To the extent that the foregoing rejections are deemed applicable to the new claims, the rejections are respectfully traversed.

Independent claim 68 recites an original watch design creating method in a design creating system having a consumer terminal and maker-side host computer connected with the consumer terminal through an information communication network. The method comprises the steps of providing in the maker-side host computer, a watch parts digital information indicating watch constituent parts and a design software to the consumer terminal, and receiving in the consumer terminal, the watch parts digital information indicating watch constituent parts and the design software from the maker-side host computer. In the consumer terminal, an original watch design information is created by using the design software so as to combine the watch parts digital information, the original watch design information is transmitted from the consumer terminal to the maker-side host computer, and the original watch design information is received in the maker-side host computer.

This method is neither disclosed nor suggested by any of <u>Matsuzaki et al.</u>, <u>Abraham et al.</u>, <u>Camaisa et al.</u>, <u>Hutton</u>, <u>Greene et al.</u>, <u>d'Huart</u>, <u>Maxey et al.</u>, nor by any reasonable combination of these references.

<u>Matuzaki et al.</u> discloses a system that manufactures products according to an order from a customer. Fig. 6 shows a hardware arrangement for the system. In <u>Matuzaki et al.</u>, the customer inputs his order by using a customer indication input unit 1-1 (*See* column 9, lines 10 - 41). Since a customer has to use the input unit 1-1 to input an order, the customer in <u>Matuzaki et al.</u> does not need to receive software that creates a design for a customer's products through an information communication network from a host computer.

Accordingly, <u>Matuzaki et al.</u> does not disclose or suggest a host computer providing digital information and design software that creates an original design from digital information, to a consumer terminal through an information communication network, as recited in new claim 68. Further, <u>Matuzaki et al.</u> does not disclose or suggest the creation of an originally designed and unique watch.

<u>Andersen et al.</u> discloses a system in which a Manufacturer's computer receives an order from a remote order computer (30) and produces an art design window according to the received order. However, as shown on column 12, lines 21 - 38, the remote order computer (30) is installed at a retail or distributor establishment. A customer must go to the retailer or distributor and input an order by using the remote order computer (30). The remote order computer (30) does not need to receive software that creates a design for a customer's product through an information communication network from a host computer.

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Accordingly, <u>Andersen et al.</u> does not disclose or suggest a host computer providing digital information and design software, which creates an original design from the digital information, to a consumer terminal through an information communication network, as recited in new claim 68. Further, <u>Andersen et al.</u> does not disclose or suggest the creation of an originally designed and unique watch.

<u>Camaisa et al.</u> discloses a system by which customers can request the display of full-color images of menu items as to help decide what to order. However, as shown in Figs. 5, 10 - 15, the system in <u>Camaisa et al.</u> can only select one item from the given menu and therefore the system cannot create new foods. For example, in Fig. 9, when the customer selects "CAPPELLINI CARDINALE", the system displays pasta as shown in Fig. 10.

Accordingly, <u>Camaisa et al.</u> does not disclose or suggest that a host computer provides digital information and design software, which creates an original design from the digital information, to a consumer terminal through an information communication network, as recited in new claim 68, nor does <u>Camaisa et al.</u> disclose or suggest the creation of an originally designed and unique watch.

<u>Hutton et al.</u> discloses a kiosk system by which customers can select flowers, flower configurations and floral arrangements. However, <u>Hutton et al.</u> does not disclose or suggest that a host computer provides digital information and design software, which creates an original design from the digital information, to a consumer terminal through an information communication network, as recited in new claim 68. Nor does <u>Hutton et al.</u> disclose or suggest the creation of an originally designed and unique watch.

Green et al. and d'Huart disclose specific watch designs and neither discloses or suggests a host computer that provides digital information and design software for creating an original design from the digital information to a consumer terminal through an information communication network.

Maxey et al. discloses explanations of commands of new CAD software. However, Maxey et al. does not disclose or suggest a host computer that provides digital information and design software, for creating an original design from the digital information, to a consumer terminal through an information communication network. Further, Maxey et al. does not disclose or suggest the creation of an originally designed and unique watch.

It is apparent, therefore, that none of the cited references disclose or suggest a host computer providing digital information and design software, which creates an original design from the digital information, to a consumer terminal through an information communication network, as stated in new claim 68. In addition, none of the cited references disclose or suggest that the creation of an originally designed and unique watch.

Accordingly, Applicants submit that new claim 68 is not anticipated under 35 USC § 102 by any of the cited references.

Further, even if all the cited references were to be combined by a person with ordinary skill in the art, the invention defined by claim 68 would not be achieved. Accordingly, claim 68 defines patentable subject matter under 35 USC § 103.

Since claims 69-81 depend on claim 68, they also meet the requirements for novelty and patentability under 35 USC § 102 and § 103, and should be allowed.

Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

If any extension of time under 37 C.F.R. § 1.136 is required for entry of this response, and not accounted for by an attached request and fee payment by check, please grant such extension and charge the required fee to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: June 6, 2003

By: _____

Robert F. Ziems
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Amended Paragraphs in Specification

Page 11, first full paragraph

Figure 3 is a flowchart of basic operation at the consumer who received the storage medium from the clock maker. That is, this flowchart shows concretely the step 814. The following steps are executed based on a control program (see number 1 in Fig. 13) within the CD-ROM as the storage medium provided from the clock maker. As mentioned below, the CD-ROM records the following information (see number [9] 2 in Fig. 13), i.e., dial-plate information, hour and minute hands information, watch case information, color information, wrist band information, buckle information, time-indicator information, order information, and other information (for example, message information), as the parts design information which can be selected by the consumer.

Page 12, third full paragraph

First, as the main menu, "EXPLANATION", "READ", "IMAGE CHECK", "DESIGN", "HOLD IMAGE" and "END" are displayed (step S31). Next, "EXECUTING DATA" is checked (step S32). Next, when "EXPLANATION" is clicked, the image is moved to the abstract of the present invention (step S33). Next, when "READ" is clicked, order data created by the consumer are read and the image is moved to the custom display (step S34). Next, "IMAGE CHECK" is clicked, the image is moved to the display of the image check (see Fig. 15 and

step S35). Next, "DESIGN" is clicked, the image is moved to the display of the custom sample pattern representing the sample pattern (see Fig. 17 and step S36). Next, "HOLD IMAGE" is clicked, the image is moved to the display of the holding image (see Fig. 30 and step S37). Next, "END" is clicked, the current program is finished (step S38).

Paragraph bridging pages 12 and 13

First, three questions are displayed in order to execute the image check. When all questions are answered, the result of the image check is displayed (see Fig. 16 and step S41). Next, the menu of "HOLD", "DESIGN" and "RETRY" are displayed, and, for example, the image of five watches is displayed (step S42). Next, when the image of an optional watch is clicked, and when "DESIGN" is clicked, the image is moved to the display of the custom selection (see Fig. 18), [and] (step S43). Next, when the image of the optional watch is clicked, and when ["IMAGE"] "HOLD" is clicked, the image is moved to the holding image (see Fig. 30), [and] (step S44). Next, when "RETRY" is clicked, the image is returned to the display of the image check, and the image check is retried (step S45).

Paragraph bridging pages 14 and 15

Next, when "MAGNIFYING GLASS" is clicked, the image of the dial-plate is enlarged (see Fig. 21 and step 557). In the case of Fig. 21, ["ILLUSTRATION/CHAR ACTERS"] "ILLUSTRATION/CHARACTERS" is shown instead of "MESSAGE". Finally, "HOLD" is clicked, the image is moved to the holding of the image (Fig. 30) to hold the custom watch which is currently

created (step S58). Further, "READ" is clicked, the dial-plate created by the consumer is read out from the file, and it is displayed on a vacant space within six spaces (see Fig. 25).

Page 15, second full paragraph

Next, the window for confirming the dial-plate is displayed (see Fig. 20), [and] (step S62). Further, "CONFIRM", "CANCEL", "HOLD" and "RETURN" are displayed (step S63). When "CONFIRM" is clicked (step S64), Figure 18 is displayed and the selected dial-plate is displayed on the vacant space. When "CANCEL" is clicked, the confirmation window is closed (step S65), and Figure 19 is displayed.

Page 15, third full paragraph

Figure 8 shows concrete steps of selection of the custom sample in step S23 shown in Fig. 3 (No.3). First, when the illustration/characters, (for example, "Happy Birthday") is input (step S71). Next, when "MAGNIFYING GLASS" is clicked, the case, the time indicator, hands, the dial-plate, the crown, the message, etc., are enlarged and displayed (step S72). Next, "CLOSE" is checked, the enlarged window (Step S32). Next, an image file of the created dial-plate is read (step S74).

Page 16, second full paragraph

Next, the input of the message is explained below (see Fig. 24). First, a favorite font (for example, Gothic font, Ming font, etc.,) is selected from different fonts. The color of character is selected from ten colors displayed on the right

side. When "HANDS" is clicked, one hand is selected from five kinds of hands. When "HOLD" is clicked, the image is moved to the holding image. Next, the case is selected as shown in Fig. 26. When "WATCH CASE" is clicked, changeable watch cases are displayed, and the desired watch case is selected therefrom. When the desired watch case is selected, the color of the watch case of the watch is changed. When "HOLD" is clicked[.], the image is moved to the holding image.

Page 17, first full paragraph

Further, when the watch case or watch band is selected, it is possible to read the original design (i.e., parts digital information) created by the consumer himself. The clock maker arranges the original design to, for example, the front surface of the band, and provides it to the customer as the [custer's] customer's originally-designed band and as the only one of its kind in the world. When the material of the band is made of resin, such as urethane foam, an original design is printed. The watch case is also printed.

Page 18, first full paragraph

Figure 9 shows concrete steps of display of the holding image in step S24 shown in Fig. 3. First, as shown in Fig. 30, the holding image is displayed, and "ORDER", "HOLD", "CHANGE OF DESIGN", "DELETE", etc., are displayed (step S81). Anyone of watches is selected when the customer orders next, and "ORDER" is clicked (see Fig. [31] 30, step S82). Further, when the image is held, anyone of watch is selected and "HOLD" is clicked (see Fig. [31] 30), [and]

Page 4 of 6

(step S83). Next, when the design is changed after selection of optional watch, "CHANGE" is clicked (step S84). Further, the image is moved to the custom image so as to change the design coordinate. When "DELETE" is clicked, the selected watch is erased. As shown in Fig. 31, the final confirmation image is displayed in order to confirm the ordered watch (step S85). Further, "CONFIRM" is clicked (step S86), and the display is moved to Figure 32. When "CANCEL" is clicked, the display is moved to three holding image (see Fig. 30).

Page 18, second full paragraph

Figure 10 is a flowchart for confirming color tone. First, the clock maker asks the consumer whether confirmation of color tone is necessary or not (see Figs. [30] 32 and 33). The consumer requests the confirmation of the color tone from the clock maker (step S92). The clock maker prints some samples which some sample colors are combined with peripheral color tones in accordance with the request, and sends them to the consumer (step S93).

Paragraph bridging pages 19 and 20

Figure 13 is an explanatory view for explaining contents of storage medium used in the present invention. The storage medium is provided from the clock maker to the consumer, and the CD-ROM shown in Fig. 12 corresponds to this drawing. The reference number 2 represents parts digital information. As the parts digital information, the dial-plate information, the pointers information, the watch case information, the color information, the wrist band information, the buckle information, the time indicator information, the order information, the

message information, etc., are recorded in the CD-ROM. The reference number

1 represents another control program necessary for parts selection.